

REMARKS

This responds to the Office Action dated February 9, 2007 and the Advisory Action dated April 18, 2007.

Claims 1, 16, and 22 are amended. Claims 1, 3-16, 18-22 and 24-26 are pending in this application. Detailed responses to the rejections are as follows:

§102 Rejection of the Claims

Claims 1, 4, 16 and 19-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bush (U.S. Patent No. 5,755,762). The Applicant respectfully traverses the rejection and requests the Office to consider the following.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”¹ With respect to anticipation rejections, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*”² “The identical invention must be shown in as complete detail as is contained in the ... claim.”³

Bush is entirely devoid of teaching any molecular weights to provide the interested public with sufficient knowledge as to what is her incidental teaching to use polyethylene. Because “[t]he identical invention must be shown in as complete detail as is contained in the ... claim”, *Richardson*, and because Bush is entirely silent on the molecular weight of eUHMWPE, Bush does not anticipate the claims.

Moreover, Bush suggests her covering “reduce fibrous ingrowth” (Bush at column 6, line 14), and Applicant expressly teaches “eUHMWPE can have an expanded matrix that nevertheless repels fibrotic tissue ingrowth” (see claim 16).

Withdrawal of the rejection is respectfully requested.

¹ (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), M.P.E.P. §2131, 8th Ed., Rev. 4).

² *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

³ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

§103 Rejections of the Claims

Claims 1, 3-14, 16 and 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukup et al. (U.S. Patent No. 6,704,604) in view of Bush (U.S. Patent No. 5,755,762). Applicant respectfully traverses the rejection and requests the Office to consider the following.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (M.P.E.P. § 2143 8th Ed, Rev.4).

The Office admits in this rejection that Soukup et al. fail to teach eUHMWPE. Bush is discussed above.

Because all the claim limitations are not taught in the cited references, withdrawal of the rejection is respectfully requested.

Claims 15, 22 and 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukup et al. (U.S. Patent No. 6,704,604) in view of Bush (U.S. Patent No. 5,755,762) as applied above, and further in view of Czura et al. (U.S. Patent No. 5,562,715). Applicant respectfully traverses the rejection and requests the Office to consider the following.

The Office Action admits that “Soukup … fails to teach that the porous covering may included ‘expanded ultra-high molecular weight polyethylene.’ ” (Office Action at page 4). The Office Action also admits that “Soukup … fails to disclose a dielectric coating over the metallic can, and a passageway through the dielectric coating to form an exposed portion of the container. Consequently by this admission, Soukup fails to teach at least two claim limitations.

Bush is discussed above.

Czura fails to teach an expanded ultra high molecular weight polyethylene.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Page 9

Serial Number: 10/662,129

Dkt: 279.445US1

Filing Date: September 12, 2003

Title: EXPANDED ULTRA-HIGH MOLECULAR WEIGHT POLYETHYLENE IN AN ELECTRICAL MEDICAL DEVICE

Because all the claim limitations are not taught in the cited references, withdrawal of the rejection is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6912 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DANIEL J. COOKE ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6912

Date May 9, 2007

By T.E.B.

Timothy E. Bianchi
Reg. No: 39,610

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22314-1450 on this 9 day of May 2007.

Paula Suchy
Name

Paula Suchy
Signature